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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,504	09/22/2003	Richard L. Weber	12177-004001	6838
26171	7590	12/06/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			HOGE, GARY CHAPMAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/665,504	WEBER, RICHARD L.
	Examiner Gary C. Hoge	Art Unit 3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 September 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-57 is/are pending in the application.
 4a) Of the above claim(s) 23-57 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-8,13-15 and 17-20 is/are rejected.
 7) Claim(s) 9-12,16,21 and 22 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 23-57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 30, 2004.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of McClain.

Lee discloses a communications device comprising a panel **13** having a front face and an inside face; a housing **23** having a front side, a rear side, and multiple edges, wherein the panel is affixed to the housing such that the inside face of the panel can be folded flush against the front side of the housing; one or more electronic components housed within the housing, wherein the electronic components include, a switch **44** that when depressed initiates a recording process to record an audio message; a memory **43** to store the audio message for repeated playing; a processor **41**; a power source **42**; and an input/output audio device to record and play the audio message. However, Lee does not disclose a multi-page attachment affixed to the inside face of the panel. McClain teaches that it was known in the art to affix a multi-page stamp booklet to the inside face of a foldable panel. It would have been obvious to one having ordinary skill in the art

at the time the invention was made to provide the greeting card disclosed by Lee with a multi-page stamp booklet, as taught by McClain, in order to give the stamps as a gift to the recipient of the card.

Regarding claim 2, see column 3, line 29.

Regarding claim 3, it is not known what material is used to fabricate the housing.

Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that plastic would be suitable for the fabrication of a housing, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the housing disclosed by Lee from plastic as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Regarding claims 4 and 6, the recitation that the booklet depicts a visual message providing information about a product does not patentably define over Lee because it has been held that patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. *In re Montgomery*, 102 USPQ 248.

Regarding claims 5 and 6, Fig. 2 of McClain shows the attachment being folded-out.

Regarding claim 14, see Fig. 2. When panel 212 is closed, the switch 45 is not visibly perceivable.

Regarding claim 15, the outline of the panel 212 constitutes a template that allows a user to locate the switch.

4. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of McClain as applied to claim 1 above, and further in view of Cangelli.

Lee discloses the invention substantially as claimed, as set forth above. However, Lee does not disclose a transparent holder attached to the inside face of the greeting card. Cangelli teaches that it was known in the art to provide a transparent holder to the inside of a greeting card. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the greeting card disclosed by Lee with a transparent holder, as taught by Cangelli, in order to give a jigsaw puzzle as a gift to the recipient of the card.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of McClain as applied to claim 1 above, and further in view of Pines.

Lee discloses the invention substantially as claimed, as set forth above. However, Lee does not disclose an activation tab to activate the playing of the audio message. Pines teaches that it was known in the art to provide an activation tab **220** to activate an audio greeting card. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the card disclosed by Lee with an activation tab, as taught by Pines, in order to automate the operation of the card.

6. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of McClain as applied to claim 1 above, and further in view of Phillips.

Lee discloses the invention substantially as claimed, as set forth above. However, Lee does not disclose the use of labels to supply the printed material that is commonly featured on multiple surfaces of a greeting card. Phillips teaches that it was known in the art to supply such printed indicia on labels. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to provide the card disclosed by Lee with labels, as taught by Phillips, in order to enable the user to customize the text that appears on the greeting card.

Regarding claim 19, a label also constitutes a card.

Response to Arguments

7. Applicant's arguments filed September 26, 2005 have been fully considered but they are not persuasive.

Applicant has requested reconsideration and withdrawal of the above-stated rejections "because there would have been no motivation to combine Lee and McClain in the manner set forth in the rejection." On the contrary, the motivation is as set forth above. Further, it is noted that motivation can be found, not only in what is explicitly stated in prior art references, but also in what is generally known in the art.

Lee discloses an audio/visual greeting device. Such devices are intended to be mailed to a recipient, like any other greeting card. It is well known to enclose a gift with a greeting card, and it is also well known to attach that gift to the inside cover of the card. See, e.g., GB 2,116,478 or US 2003/0150142, cited in the previous Office action. Further, it is well known that anything that can be attached to the inside cover can be sent as a gift, and the selection of a specific gift is at the discretion of the sender. In other words, the sender can select anything that is known to be attachable within the greeting card, and the selection of any such object would have been obvious. McClain teaches that it was known in the art to attach a book of stamps to the inside cover of a booklet, and thus, it was known in the art that a book of stamps was one of the objects from which a sender could choose.

Allowable Subject Matter

8. Claims 9-12, 16, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge
Primary Examiner
Art Unit 3611

gch